



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,243	11/03/2000	George Norbert Cox III	019496-002220US	6940

23419 7590 12/01/2003

COOLEY GODWARD, LLP  
3000 EL CAMINO REAL  
5 PALO ALTO SQUARE  
PALO ALTO, CA 94306

EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/706,243

Applicant(s)

COX ET AL.

Examiner

John S. Brusca

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

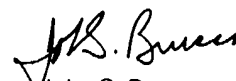
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 118-183.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). filed 04 January 2002.
10. ☐ Other: \_\_\_\_\_

  
John S. Brusca  
Primary Examiner  
Art Unit: 1631

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejections for obviousness type double patenting over U.S. Patents 6,534,261, 6,607,882, and copending application 09/897,844 in view of the terminal disclaimer filed 03 November 2003 which has been accepted.

Continuation of 5. does NOT place the application in condition for allowance because: The applicant's comments are not persuasive because the applicants have failed to provide evidence that zinc finger proteins could be delivered to cells both in vivo and in vitro and further function to modulate expression of an endogenous cellular gene in a manner that is described in the specification at the time of filing. The Pabo declaration does not provide evidence for enablement, rather it merely contains assertions by the declarant. The comments concerning the Yeh et al. abstract are not persuasive because the Yeh et al. declaration is not enabling. It is noted that the Office action mailed 01 July 2003 was incorrect in that the Yeh et al. declaration was characterized as not addressing delivery of proteins in vivo, when in fact such in vivo delivery was mentioned. The applicants have provided a declaration by Case that further discusses the experiments conducted by Yeh et al. However the Case declaration is not persuasive because it does not provide evidence that zinc finger protein delivery was effected by liposomes. The only delivery method the specification provides guidance to use is delivery by liposomes. Post filing experimentation that delivers proteins in ways not supported by the specification at the time of filing is not persuasive as to enablement of the specification. The specification discusses a number of internalization sequences at pages 45-50, however the Case declaration only provides evidence that one of the described internalization sequences, antennipedia domain, is effective for protein internalization in figure 5. It is not clear from the Case declaration whether figure 5 describes delivery to in vitro or in vivo cells, or what delivery method was used.. Because the applicants have failed to provide evidence that the described liposome delivery method and internalization sequences can be used in in vivo and in vitro cells to deliver zinc finger proteins to function to modulate expression of an endogenous gene, the enablement rejection of claims 118-183 is maintained. .